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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/011,634	04/03/1998	MARC ARONHIME	P16370	1164

7590 11/24/2003

William H. Dippert  
Reed Smith LLP  
599 Lexington Avenue  
29th Floor  
New York, NY 10022

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/24/2003

38

Please find below and/or attached an Office communication concerning this application or proceeding.

C2038

# Office Action Summary

Application No.

09/011,634

Applicant(s)

Aronhime et al.

Examiner

Bruce Hess

Group Art Unit

1774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 7-24-03 (Amendment)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 29-45, 66-76 and 80-84

is/are pending in the application.

Of the above claim(s) \_\_\_\_\_

is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_

is/are allowed.

☒ Claim(s) 29-45, 66-76 and 80-84

is/are rejected.

☐ Claim(s) \_\_\_\_\_

is/are objected to.

☐ Claim(s) \_\_\_\_\_

are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other: \_\_\_\_\_

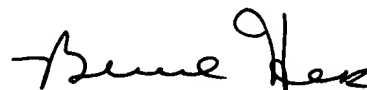
Office Action Summary

1. Upon reconsideration, all previous rejections of record are no longer adhered to.
2. Claims 29-45, 66-76 and 80-84 are rejected under 35 USC 112 (first paragraph) as being broader than the enabling disclosure as a result of applicants' failure to recite that the outer release layer has a thickness of less than 1 mm and contains less than 10% silicone oil and 4% filler material.

Applicants' showing of "non-tackiness" is limited to the use of materials having the above parameters. Absent these parameters, there is no basis of support for the present "non-tacky " recitation.

3. Claims 29, 35-41, 76 and 80-84 are recited under 35 USC 102(b) as being anticipated by applicants' statement of the prior art.

These claims read on a compound (i.e. a condensation cured silicone which is an acknowledged known material) on a generic base layer. As known compounds, it is inherent that condensation cured silicones have come into contact with a substrate (i.e., a "base layer"). Such a structure (i.e., a known compound on a generic substrate ) reads on the articles recited in claims 29, 35-41, 76 and 80-84. Since "less than" includes zero %, claims 35-41 and 80-82 are also anticipated.



BRUCE H. HESS  
PRIMARY EXAMINER